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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 178

MITCHELL FOODS, INC. and FRANK S. MITCHELL,
Petitioners,

vs.

RICH PRODUCTS CORPORATION,
Respondent.

PETITIONERS' REPLY BRIEF

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No. 1360

PETITIONERS' REPLY BRIEF

Respondent's brief agrees (p. 5) that the Court of Appeals decision on the issue of obviousness was based squarely upon Judge Learned Hand's earlier decisions in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (2 Cir. 1955) and *Reiner* v. *I. Leon Co.*, 285 F. 2d 501 (2 Cir. 1960). The question then is whether the Court of Appeals for the Second Circuit, in continuing to base its decision as to obviousness on these authorities, is in direct conflict with the recent decisions of this Court in *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966) and *United States* v. *Adams*, 383 U. S. 39 (1966). Respondent argues that there is no conflict, and criticizes petitioners for failing to quote from these decisions. In *Graham*, this Court said (p. 16):

> "It is contended, however, by some of the parties and by several of the *amici* that the first sentence of § 103 was intended to sweep away judicial precedents and to lower the level of patentability."

and (p. 17):

> "We believe that this legislative history, as well as other sources, shows that the revision was not

intended by Congress to change the general level of patentable invention."

and (p. 19):

> "Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of § 103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in § 103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. Technology, however, has advanced—and with remarkable rapidity in the last 50 years. Moreover, the ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an evenhanded application to require that those persons granted the benefit of a patent monopoly be charged with an awareness of these changed conditions."

As contrasted with the foregoing, Judge Hand in the *Lyon* case in 1955 said (pp. 534-5):

> "Therefore we at length come to the question whether Lyon's contribution, his added step, was enough to support a patent."
>
> • • •
>
> "On the other hand it must be owned that, had the case come up for decision within twenty, or perhaps, twenty-five, years before the Act of 1952 went into effect on January 1, 1953, it is almost certain that the claims would have been held invalid. The Courts of Appeal have very generally found in the recent opinions of the Supreme Court a disposition to insist upon a stricter test of invention than it used to apply—indefinite it is true, but indubitably stricter than that defined in § 103."

Judge Hand, in the *Lyon* case, referred to *Hotchkiss* v. *Greenwood*, 11 How. 248. But it is apparent from his de-

cision as a whole that he considered § 103 to be a legislative act that wiped out a "stricter" standard of patentability applied by this Court during the preceding 25 years.

In *Reiner*, in 1960, Judge Hand sustained a patent on a hair curler largely because of its great commercial success. After referring to his previous decision in the *Lyon* case, Judge Hand said (p. 503):

> "There can be no doubt that the Act of 1952 meant to change the slow but steady drift of judicial decision that had been hostile to patents which made it possible for Mr. Justice Jackson in dissent to speak of the 'strong passion in this Court for striking them' (patents) 'down so that the only patent that is valid is one which this Court has not been able to get its hands on.'"
>
> * * *
>
> "We still cannot escape the conclusion—as we could not when Lyon *v.* Bausch & Lomb Optical Co., supra, was decided in 1955—that Congress deliberately meant to restore the old definition, and to raise it from a judicial gloss to a statutory command."

There is no doubt that Judge Hand's interpretation and application of § 103 in the *Lyon* and *Reiner* cases is in direct conflict with this Court's recent decisions in the *Graham* and *Adams* cases which, unlike Judge Hand's reasoning, emphasize the great advance in technology in the last 50 years.

The *Graham* and *Adams* decisions also specifically reaffirm this Court's previous decision in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327 (1945) as well as in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320 (1945) and *Mandel Bros.* v. *Wallace*, 335 U. S. 291 (1948). The Court of Appeals for the Second Circuit has refused to follow those prior decisions which were called to its attention in our Petition for Rehearing, and which on the undisputed facts of this case compel a decision of "obvious". Respondent's brief (p. 12) mentions the *Sinclair* case in passing but ignores the *Dow* and *Mandel* decisions.

Obviousness Turns On The Essential Undisputed Facts Summarized In Question 2 In The Petition

Respondent's brief does not deny any of the essential facts set forth on pages 3 and 4 of the petition, but argues (pp. 14-15) that "secondary considerations" such as commercial success "indicate a lack of obviousness".

Admittedly, the patent claims call for the combination of (a) water, (b) fat, (c) a substituted cellulose (preferred example, methyl cellulose), and (d) a second emulsifying agent, one of the Spans, Tweens, etc. Methyl cellulose, according to the patent in suit at column 2, lines 11 to 17 (PE 3), acts as one emulsifying agent.

The prior British patent likewise describes a whipped cream substitute made with (a) water, (b) fat, (c) emulsifying agent "B" (preferred example, methyl cellulose; DE 99, column 1, last line; DE 101, column 1, line 5), and (d) a second emulsifying agent "A" composed of vegetable gum and salts.

The sole distinction of the patent claims over the prior British patent is the use of one of the more modern Spans, Tweens, etc. in place of the vegetable gum-salt mixture, emulsifier "A", of the British patent.

Respondent's argument (pp. 5-6, 14-15) about the advantages of a non-protein, methyl cellulose formula is a complete red herring. The prior British patent describes on its face just such a non-protein, methyl cellulose formula pointing out the very same advantages (DE 99, lines 11-18; DE 100, lines 52-60; DE 102, lines 70-77).

The prior Pratt article (not before the Patent Office) described the prior use of the claimed emulsifiers Spans and Tweens to improve the whippability of ice cream and natural whipping cream. Dr. B. L. Oser, respondent's expert, when cross-examined about the non-ionic surfact-

ants (another term for emulsifiers) of the Pratt article, testified (DA 243):

> "Q. * * * In a water, fat, cellulose ether system which you desire to emulsify in order to obtain a whippable emulsion and in which your surfactants have been employed, would you choose to investigate the nonionic surfactant?
>
> "A. Yes, I would."

He then went on to say (DA 243-4) why these were logical emulsifiers to try in a whippable emulsion.

The undisputed essential facts of this case require a holding of "obvious" under the guidelines of this Court's most recent decisions. The Court of Appeals for the Second Circuit has refused to follow the decisions of this Court and is in direct conflict therewith.

Respectfully submitted,

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